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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,070	04/02/2004	Michael K. Brown	555255-012714	2683
<div>7590 02/05/2008</div> <div>John V. Biernacki, Esq. JONES DAY North Point 901 Lakeside Avenue Cleveland, OH 44114</div> <div>EXAMINER SAN JUAN, MARTINJERIKO P</div> <div>ART UNIT PAPER NUMBER 2132</div> <div>MAIL DATE DELIVERY MODE 02/05/2008 PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/817,070

Applicant(s)

BROWN ET AL.

Examiner

Martin Jeriko P. San Juan

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a response to Applicant's Remarks filed on November 1, 2007.

Claims 1-26 were originally pending.

Claims 23 and 24 have been cancelled. Claims 1-20, 25, and 26 have been amended.

New claim 27 has been added.

Claims 1-22, and 25-27 are currently pending.

Response to Arguments

1. Applicant's arguments and amendments, see Remarks, filed on November 1, 2007, with respect to 35 USC 112, second paragraph, have been fully considered and are persuasive. The rejections under 35 USC 112, second paragraph have been withdrawn.
2. Applicant's arguments filed on November 1, 2007 have been fully considered but they are not persuasive.

The Applicant respectfully alleges that the cited references do not disclose the subject matter of the rejected claims. Bandini does not disclose the subject matter of claim 1, namely that a reason is determined for the issue resulting from the validity check and that reason is provided to the user of a mobile device. Bandini is only disclosing notification that an issue has arisen and does not provide any functionality for providing

the underlying reason behind the issue. The simple notification in Bandini that an issue exists results in a significantly less efficient approach in allowing a mobile user to take ameliorative action, such as to take corrective action more quickly in order to allow the anticipated communication to take place once the issue is resolved. Applicant's arguments with respect to other claims centers around the issue that Bandini does not teach having a reason for the issue resulting from the validity check.

The Examiner respectfully disagrees. The Examiner previously cited US 2002/0169954 A1, Pg 5, Par 0044 to teach the steps of determining a reason for the validity check issue, and wherein the reason for the validity check issue is provided to the mobile device's user. These limitations are inherent in the Policy Managers performing specifically in the stages of annotation, notification, and disposition actions. The Examiner acknowledges the concerns of the Applicant that a reason(s) is not determined for the issue resulting from the validity check. The Examiner points out starting in Pg 5, Par 0045, an example of a policy being triggered which provides further evidence of the extent of information that is included in the annotation and notification actions. Par 0045-0047 shows extensively a policy in execution that a digital signature should be detected and verified in accordance with signature attributes. In the end of the execution of a policy being triggered, Bandini discloses that "the security manager provides a corresponding result notification to the policy manager so as to facilitate proper follow up actions, such as rejection or acceptance of the e-mail message (Par 0047)." This is evidence of the extent of information that is included in the Annotation,

Notification actions of a Policy Manager whenever a policy issue has arisen. The extent of information that is included in the annotation/notification suggests or implies "a reason(s) for any validity check issues," since "corresponding result notification" would have suggested or implied to include information of any point of failures that have occurred during the execution of a policy, "so as to facilitate proper follow up actions, such as rejection or acceptance of the e-mail message."

3. Upon further consideration of amendments with the subject matter being directed to a wireless mobile communication device, rejections under 35 USC 102(e) are being withdrawn in favor of a new ground(s) of rejection being made under 35 USC 103(a) over previously cited art by Bandini and further in view of Baer. Refer to Prior Art Rejection section below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claim 1-22, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandini et al. [US Pub 2002/0169954 A1], hereinafter Bandini, and further in view of Baer et al. [US PN 6782266 B2], hereinafter Baer.

a. Based on independent claim 1, Bandini et al. teach a method for handling on a communication device a secure message to be sent from the communication device to a recipient, comprising the steps of: receiving data at the communication device about a security key associated with the recipient [Security services that involve verification of digital certificates inherently teaches receiving data at the communication device about a security key associated with recipients. US 2002/0169954 A1, Pg 4, Par 0037]; using the received data to perform a validity check with respect to using the security key associated with the message recipient to send a secure message to the recipient [US 2002/0169954 A1, Pg 4, Par 0037]; wherein an issue exists due to the validity check; determining a reason for the validity check issue [Notification actions are caused during a given policy being triggered and executed. US

2002/0169954 A1, Pg 5, Par 0044]; wherein the reason for the validity check issue is provided via a user interface on the mobile device [The issue is what is being notified.]. Bandini does not teach wherein the communication device is a wireless mobile communication device.

Baer teaches a mobile communication device as being a wireless mobile communication device [US PN 6782266 B2, Col 6, Ln 55].

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bandini et al. by coupling the wireless communication system with the server network using various communication links such as wireless gateways [US PN 6782266 B2, Col 2, Ln 57-66]. The suggestion/motivation for combining would have been to provide the need of allowing wireless communication devices [US PN 6782266 B2, Col 1, Ln 34-37]. Baer is analogous art because it is in the same inventive field of endeavor of computer networking.

b. With regard to dependent claim 2, Bandini and Baer teach the method of claim 1, wherein a message is provided via the user interface indicating that a problem exists with respect to sending the secure message to the recipient in addition to indicating the reason related to the problem [Notifications can be sent to sender, recipient or any email address that is defined by the administrator. US 2002/0169954 A1, Pg 5, Par 0044].

c. With regard to dependent claim 3, Bandini and Baer teach the method of claim 1, further comprising the step of resolving the validity check issue through use of the information provided in the validity check reason, wherein the secure message is sent after resolution of the validity check issue by the user

[Disposition or alternative actions, after a notification action, are available. US 2002/0169954 A1, (Pg 5, Par 0044), (Pg 9, Par 0064)].

d. With regard to dependent claim 4, Bandini and Baer teach the method of claim 1, wherein the security key is a public key, wherein a user composes the secure message, wherein the composed message is to be encrypted using the recipient's public key [This is inherent in S/MIME protocol. US 2002/0169954 A1, Pg 4, Par 0037].

e. With regard to dependent claim 5, Bandini and Baer teach the method of claim 4, further comprising the steps of: creating a list of all recipients for the composed message; receiving data about the recipients' public keys that includes certificate information associated with the recipients; and performing the validity check with respect to the certificate information associated with the recipients [Secure electronic message is capable of sending to multiple recipients.]

f. With regard to dependent claim 6, Bandini and Baer teach the method of claim 1, further comprising the steps of: determining whether a certificate for an intended recipient can be located; providing as a validity check reason that the intended message recipient's certificate was not located [Digital certificate

verification involves querying local directories or trusted remote servers. US 2002/0169954 A1, Pg 6, Par 0047].

g. With regard to dependent claim 7, Bandini and Baer teach the method of claim 6 further comprising the step of removing a recipient whose certificate was not located before sending a secure message to another recipient. [A certificate that is deemed invalid, inherently being the recipient, is discarded from the acceptable certificate list. US 2002/0169954 A1, Pg 8, Par 0058].

h. With regard to dependent claim 8, Bandini and Baer teach the method of claim 6 further comprising the step of cancelling sending the message to a recipient whose certificate was not located [The message can be deleted. US 2002/0169954 A1, Pg 9, Par 0064].

i. With regard to dependent claim 9, Bandini and Baer teach the method of claim 6, further comprising the step of: determining whether the certificate for the intended recipient is locally available on the mobile device [Security manager queries trusted remote or local directories for digital certificate verification. US 2002/0169954 A1, Pg 6, 0047].

j. With regard to dependent claim 10, Bandini and Baer teach the method of claim 6, further comprising the step of: determining whether the certificate for the intended recipient is remotely available [Security manager queries trusted remote or local directories for digital certificate verification. US 2002/0169954 A1, Pg 6, 0047].

k. With regard to dependent claim 11, Bandini and Baer teach the method of claim 5, further comprising the step of collating certificates that correspond to the recipients before performing the validity check [Collating certificates are inherent when users are organized in a hierarchical directory type structure to facilitate grouping of users and/or domains. US 2002/0169954 A1, Pg 4, Par 0036].

l. With regard to dependent claim 12, Bandini and Baer teach the method of claim 6, wherein the message is to be encrypted using a Secure Multipurpose Internet Mail Extensions (S/MIME) scheme or a Pretty Good Privacy PGP scheme [US 2002/0169954 A1, Pg 4, Par 0037].

m. With regard to dependent claim 13, Bandini and Baer teach the method of claim 1, wherein the received data about the security key associated with the recipient includes whether a recipient's certificate is permitted to be used; wherein the validity check issue indicates that the recipient's certificate is not permitted to be used [This is inherent in security protocols implementing digital certificates especially with a Certificate Revocation Lists (CRLs). US 2002/0169954 A1, Pg 8, Par 0058].

n. With regard to dependent claim 14, Bandini and Baer teach the method of claim 13, wherein the data about whether the recipient's certificate is permitted to be used is based on a usage field contained in the certificate [US 2002/0169954 A1, Pg 8, Par 0058].

o. With regard to dependent claim 15, Bandini and Baer teach the method of claim 13, wherein the data about whether the recipient's certificate is permitted to be used is based on a control file installed on the mobile device that specifies which certifications are allowed to be used [There can be one or more CRLs which can be in trusted local or remote directories. US 2002/0169954 A1, Pg 8, Par 0058].

p. With regard to dependent claim 16, Bandini and Baer teach the method of claim 1, wherein the issue involves a validity check failure, said method further comprising the step of providing the reason of the validity check failure to the user interface on the mobile device [A validation issues and failures are inherent in the security policy causing notification actions.].

q. With regard to dependent claim 17, Bandini and Baer teach the method of claim 1, wherein the received data about the security key associated with the recipient includes strength of the recipient's certificate; and wherein the validity check issue is directed to whether the recipient's certificate is permitted to be used based upon the strength of the recipient's certificate [US 2002/0169954 A1, Pg 8, Par 0058].

r. With regard to dependent claim 18, Bandini and Baer teach the method of claim 1, wherein the received data about the security key associated with the recipient includes whether the recipient's certificate is trusted, and wherein a decision to include a recipient for a secure message is based upon whether the

recipient's certificate is trusted [This is inherent in certificate chain verification or root verification. US 2002/0169954 A1, Pg 8, Par 0058].

s. With regard to dependent claim 19, Bandini and Baer teach the method of claim 1, wherein the received data about the security key associated with the recipient includes validity and revocation status of a recipient's certificate, wherein a decision to include the recipient for the secure message is based upon the validity and revocation status of the recipient's certificate [US 2002/0169954 A1, Pg 8, Par 0058].

t. With regard to dependent claim 20, Bandini and Baer teach the method of claim 1, wherein the message is sent to the recipient despite notification of the validity check issue [The messages can be sent to the specified destinations. US 2002/0169954 A1, Pg 9, Par 0064].

u. With regard to dependent claim 21, Bandini and Baer teaches the method of claim 1, wherein means for providing a wireless network [US PN 6782266 B2, Col 2, Ln 1-15], and means for providing a message server are used to transmit the secure message from the mobile device.

v. With regard to claim 22, Bandini and Baer teach the method of claim 1, wherein the mobile device as a handheld wireless mobile communications device or a personal digital assistant (PDA) [US PN 6782266 B2, Col 6, Ln 55].

w. Claim 25 and 27 are rejected because it is the same subject matter as claim 1.

x. Based on independent claim 26, Bandini and Baer teach a wireless mobile communication device that handles a secure message to be sent from the wireless mobile communication device to a recipient, comprising: a certificate store to store certificate data [The acceptable certificate list can be stored locally along with the CRL. US 2002/0169954 A1, Pg 8, Par 0058]; means for using the stored certificate data to perform a validity check with respect to using the recipient's security key for sending the secure message to the recipient [US 2002/0169954 A1, Pg 8, Par 0058]; wherein an issue exists due to the validity check; means for determining a reason for the validity check issue; and means for providing the reason for the validity check issue via a user interface of the mobile device [US 2002/0169954 A1, Pg 5, Par 0044].

Conclusion

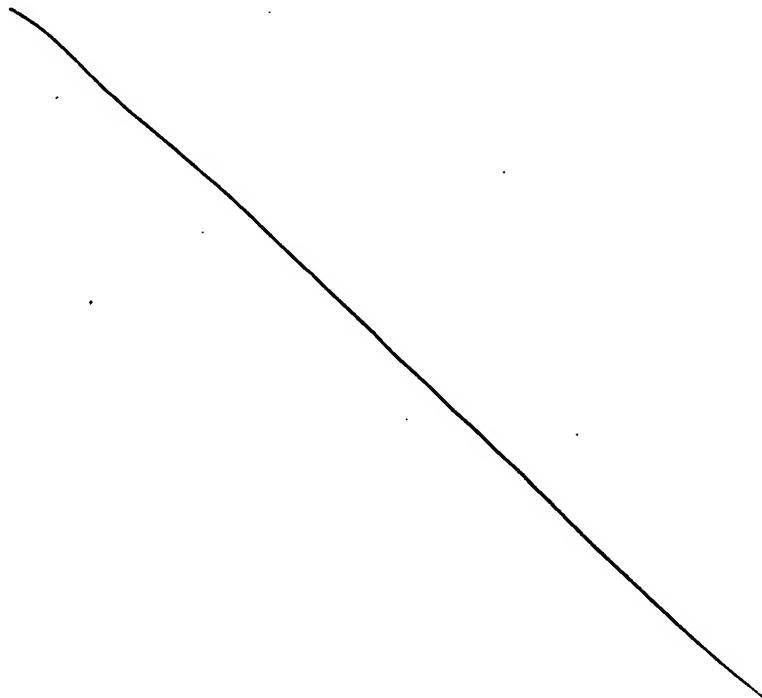
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Jeriko P. San Juan whose telephone number is 571-272-7875. The examiner can normally be reached on M-F 8:30a - 6:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Application/Control Number:
10/817,070
Art Unit: 2132

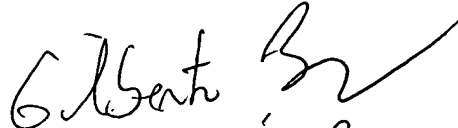
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/MJSJ/

Martin Jeriko San Juan

Examiner. Art Unit 2132


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